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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/663,183	09/15/2000	Christine Dupuis	05725.0753-00000	4212
22852	7590	07/19/2005	EXAMINER	
		FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413	MITCHELL, GREGORY W	
			ART UNIT	PAPER NUMBER
			1617	

DATE MAILED: 07/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/663,183	DUPUIS, CHRISTINE
	<b>Examiner</b>	<b>Art Unit</b>
	Gregory W. Mitchell	1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 09 May 2005.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-33, 38-82 and 87-102 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-33, 38-82 and 87-102 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
     Paper No(s)/Mail Date 08/09/05

4) Interview Summary (PTO-413)  
     Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_.

## DETAILED ACTION

This Office Action is in response to the Remarks filed May 09, 2005. Claims 1-33, 39-82 and 87-102 are pending and are examined herein.

### ***35 USC § 103 Rejection Maintained***

Claims 1-33, 38-82 and 87-102 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Blankenburg et al. (WO/99/04750 translation) in view of Firstenberg et al. (USPN 5297566) for the reasons set forth in the Office Action dated February 08, 2005.

Applicant argues, “the standard [of obviousness] is not whether the references can be combined or modified – this ‘this does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.’” This argument is not persuasive because, as set forth in the previous Office Action, “[i]t is *prima facie* obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose.... [T]he idea of combining them flows logically from their having been individually taught in the prior art.” *In re Kerkhoven*, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980). The fact that Firstenberg et al. does not exemplify a second film-forming polymer is not persuasive because Firstenberg et al. specifically teaches that *at least one* film-forming polymer may be used in the invention disclosed therein. Accordingly, the skilled artisan would have recognized multiple film-forming polymers as suitable for hair setting compositions. It is well established that consideration of a

reference is not limited to the preferred embodiments or working examples, but extends to the entire disclosure for what it fairly teaches, when viewed in light of the admitted knowledge in the art, to a person of ordinary skill in the art. *In re Boe*, 355 F.2d 961, 148 USPQ 507 (CCPA 1966); *In re Lamberti*, 545 F.2d 747, 19USPQ 279 (CCPA 1976); *In re Fracalossi*, 681 F.2d 792, 215 USPQ 569 (CCPA 1982); *In re Kaslow*, 707 F.2d 1366, 217 USPQ 1089 (Fed. Cir. 1983).

Furthermore, Applicant's arguments that *In re Kerkhoven* are not applicable to the instant case are not persuasive. Blankenburg et al. (pp. 10, 13) and Firstenberg et al. (Abstract; col. 2, lines 41-56) both teach the polymers disclosed therein as hair setting agents. Accordingly, it is Examiner's position that it would have been obvious to combine them in a composition, as claimed, for the very same purpose.

Applicant's arguments that the disclosure of Firstenberg "teaches more about the mechanical properties of its invention, than about the components of the composition used in the method and device" are not persuasive because Firstenberg et al. teaches the compositions and uses as set forth in the Office Action dated February 08, 2005, regardless of what specific aims or motivations the Firstenberg et al. may have had.

Applicant again argues that Blankenburg et al. teaches away from the claimed combination. Examiner does not agree that a person of ordinary skill in the art, upon reading the reference, would be discouraged from combining the vinylpyrrolidone/vinyl acetate/vinyl propionate copolymer of Furstenberg et al. with the polymers of Blankenburg et al. to arrive at a hair setting composition. Blankenburg et al. teaches that the problems associated with vinyl lactam polymers are also known in the art to be

remedied by plasticizers. Thus, one of ordinary skill in the art would have recognized a combination of a vinyl lactam polymer and a plasticizer could accomplish the same results as achieved by the polymers of Blankenburg et al. Accordingly, the combination of the two polymers (+ plasticizer) would have been obvious to a person of ordinary skill in the art. Please note that the compositions of Firstenberg et al. are taught to comprise plasticizers (col. 2, lines 64-68; Example 9).

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

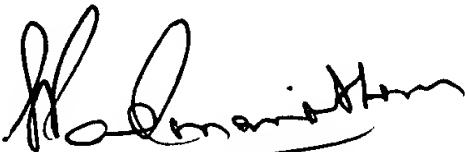
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory W Mitchell whose telephone number is 571-272-2907. The examiner can normally be reached on M-F, 8:30 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

gwm



SREENI PADMANABHAN  
SUPERVISORY PATENT EXAMINER